

CERTIFICATE OF TRANSMISSION
I hereby certify that this correspondence is being
transmitted electronically to the U.S. Patent and
Trademark Office June 26, 2007
(Date of Transmission)

FRANK C. NICHOLAS (33,983)
Name of applicant, assignee or registered representative

/FRANK C. NICHOLAS/
Signature

June 26, 2007
Date of Signature

PATENT
Case No.: AUS920010390US1
(9000/41)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re patent application of:)	
)	
KULVIR S. BHOGAL, ET AL.)	Examiner: OMARY, NAWARA
)	
Serial No.: 09/881,873)	Group Art Unit: 2683
)	
Filed: JUNE 14, 2001)	
)	
Title: TRACKING COMMUNICATIONS)	Conf. No.8232
USAGE TIME)	

APPEAL BRIEF
IN RESPONSE TO NOTICE OF NONCOMPLIANT APPEAL BRIEF

Mail Stop Appeal Briefs - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellants herewith respectfully present their Third Brief on Appeal as follows:

TABLE OF CONTENTS

1.	Real Party In Interest	3
2.	Related Appeals And Interferences	4
3.	Status Of Claims	5
4.	Status Of Amendments	6
5.	Summary Of Claimed Subject Matter.	7
6.	Grounds Of Rejection To Be Reviewed On Appeal	10
7.	Arguments	11
8.	Summary	17
9.	Claims Appendix	18
10.	Evidence Appendix	23
11.	Related Proceedings Appendix	23

1. REAL PARTY IN INTEREST

The real party in interest is Assignee INTERNATIONAL BUSINESS MACHINES CORPORATION, by virtue of an assignment executed by the inventors on June 6, 11, and 13, 2001 and filed with the United States Patent and Trademark Office on June 14, 2001, recorded at reel number 011917 frame number 0707.

2. RELATED APPEALS AND INTERFERENCES

Appellants and the undersigned attorneys are not aware of any appeals or any interferences which will directly affect or be directly affected by or having a bearing on the Board's decision in the pending appeal.

3. STATUS OF CLAIMS

Claims 1-32 are currently pending.

Claims 2-4 and 17-19 were objected to. Claims 1, 2, 6, 16, 17, 21, and 31 were rejected under 35 U.S.C. §102(e) as anticipated by Lahtinen. Claims 7-8, 22-23 and 32 were rejected under 35 U.S.C. §103(a) under Lahtinen in view of Toda. Claims 3 and 18 were rejected under 35 U.S.C. §103(a) under Lahtinen in view of Schwedes. Claims 4 and 19 were rejected under 35 U.S.C. §103(a) under Lahtinen in view of Abe. Claims 5 and 20 were rejected under 35 U.S.C. §103(a) under Lahtinen view of Kraushaar. Claims 9-11 and 24-26 were rejected under 35 U.S.C. §103(a) under Lahtinen in view of Spitaletta. Claims 14-15 and 29-30 were rejected under 35 U.S.C. §103(a) under “the above” in view of Brown.

Claims 1-32 are the claims on appeal. *See*, Appendix.

4. STATUS OF AMENDMENTS

All amendments have been entered.

5. SUMMARY OF CLAIMED SUBJECT MATTER

Independent Claim 1:

One aspect of the invention relates to a method of tracking communications usage time. In response to a call, time increments are counted 31, and a call count is determined 33 based on the counted time increments. The call count is then modified 34 based on calling plan parameters. *See*, Specification of United States Patent Application, 09/881,873 at pages 6-7.

Dependent claim 4:

Another aspect of the invention provides the method of independent claim 1 wherein the call count modification is rounding the call count to the nearest minute. *See*, Specification of United States Patent Application, 09/881,873 at pages 6-7.

Dependent claim 5:

Another aspect of the invention provides the method of independent claim 1 wherein call count modification involves subtracting an initial open connection time from the call count. *See*, Specification of United States Patent Application, 09/881,873 at pages 6-7.

Dependent claim 6:

Another aspect of the invention provides the method of independent claim 1 wherein modifying the call count involves discounting incoming calls, or discounting nighttime or weekend calls. *See*, Specification of United States Patent Application, 09/881,873 at pages 6-7.

Independent Claim 16:

A computer usable medium is also provided. The medium includes computer readable code for tracking communications usage time. In response to a call, time increments are counted 31, and a call count is determined 33 based on the counted time increments. The call count is then modified 34 based on calling plan parameters. *See*, Specification of United States Patent Application, 09/881,873 at pages 6-7.

Dependent claim 19:

Another aspect of the invention provides the medium of independent claim 16 wherein the call count modification is rounding the call count to the nearest minute. *See*, Specification of United States Patent Application, 09/881,873 at pages 6-7.

Dependent claim 20:

Another aspect of the invention provides the medium of independent claim 16 wherein call count modification involves subtracting an initial open connection time from the call count. *See*, Specification of United States Patent Application, 09/881,873 at pages 6-7.

Dependent claim 21:

Another aspect of the invention provides the medium of independent claim 16 wherein modifying the call count involves discounting incoming calls, or discounting nighttime or weekend calls. *See*, Specification of United States Patent Application, 09/881,873 at pages 6-7.

Independent claim 31:

A communications usage time tracking system includes means for counting time increments in response to a call 31, means for determining a call count based on time increments 33, and means for modifying the call count based on calling plan parameters 34. *See*, Specification of United States Patent Application, 09/881,873 at pages 6-7.

Independent Claim 32:

A system is also provided. The system includes means for tracking communications usage time. In response to a call, time increments are counted 31, and a call count is determined 33 based on the counted time increments. The call count is then modified 34 based on calling plan parameters. In one embodiment, the modified call count is stored in the memory of a cellular telephone unit. *See*, Specification of United States Patent Application, 09/881,873 at pages 6-7.

6. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 2-4 and 17-19 were objected to

Claims 1, 2, 6, 16, 17, 21, and 31 were rejected under 35 U.S.C. §102(e) as anticipated by Lahtinen.

Claims 7-8, 22-23 and 32 were rejected under 35 U.S.C. §103(a) under Lahtinen in view of Toda.

Claims 3 and 18 were rejected under 35 U.S.C. §103(a) under Lahtinen in view of Schwedes.

Claims 4 and 19 were rejected under 35 U.S.C. §103(a) under Lahtinen in view of Abe.

Claims 5 and 20 were rejected under 35 U.S.C. §103(a) under Lahtinen view of Kraushaar.

Claims 9-11 and 24-26 were rejected under 35 U.S.C. §103(a) under Lahtinen in view of Spitaletta.

Claims 14-15 and 29-30 were rejected under 35 U.S.C. §103(a) under “the above” in view of Brown.

ARGUMENTS

A) Claims 2-4 and 17-19 were objected to

The objections to claims 2-4 and 17-19 are traversed. First, Appellants note that this is the *sixth* office action and that two separate appeals have been reopened without appearing before the Board, without amending these claims, and that this is the first objection to these claims as informal. Second, there is no informality in claiming adding the modified call count. Third, Appellants have amended claims 2 and 17 to recite “summing” rather than adding. Appellants note that summing and adding are synonyms, and maintain their claim to any and all equivalents of the unamended claims, having solely made the amendment to more closely conform to the language used in the specification. With respect to the objections to claims 3 and 18, Applicant denies the existence of any informality, and note that the call count is determined based on time increments, as per the claimed elements of claim 1. Given that any potential informality has escaped the Examiner’s notice through five previous rejections and two appeals, Appellants question the Examiner’s alleged difficulty in understanding the claims. With respect to the objections to claims 4 and 19, Appellants thank the Examiner for noting the teachings of the specification, but further note that the specification speaks for itself. In addition, that the claim does not “say/show how a call count is rounded” does not make the claim informal, and that “a call count deems (sic) to be a whole number that does not require rounding” does not render the claim informal.

Withdrawal of the objections to claims 2-4 and 17-19 is requested.

B) Claims 1, 2, 6, 16, 17, 21, and 31 were rejected under 35 U.S.C. §102(e) as anticipated by Lahtinen.

The rejections to claims 1, 2, 6, 16, 17, 21, and 31 are traversed. In order for this §102(e) rejection to stand, each and every element of the claims must be disclosed in as great detail by the reference as claimed. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See also MPEP §2131.02 "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

At a minimum, Lahtinen does not disclose modifying the call count based on calling plan parameters as claimed in claims 1, 16, and 31. At most, Lahtinen discloses adding to a call counter. See, column 4, lines 3-17. No mention of calling plan parameters is included in the disclosures of Lahtinen.

In addition, Lahtinen does not disclose discounting an incoming call, as claimed in claims 6 and 21. At most, Lahtinen discloses adding call time, but not discounting any calls. See, column 4, lines 3-17.

Furthermore, claims 2, 6, 17, and 21 depend from independent claims 1 or 16 and are therefore allowable for at least the same reasons.

Withdrawal of the rejections to claims 1, 2, 6, 16, 17, 21, and 31 is requested.

B) Claims 7-8, 22-23 and 32 were rejected under 35 U.S.C. §103(a) under Lahtinen in view of Toda.

The rejection of claims 7-8, 22-23 and 32 as unpatentable over Lahtinen in view of Toda is traversed.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

With respect to claim 32, Lahtinen fails to teach or suggest modifying the call count based on calling plan parameters, as claimed. In addition, the Examiner does not rely on Toda for such a teaching, and therefore the §103(a) rejection fails on at least this ground. In addition, however, neither Lahtinen nor Toda discloses or teaches storing the modified call count in the memory of a cellular telephone unit, as claimed in claim 32. At most, Toda discloses a counter, but Toda does not disclose storing any data in the memory of a cellular telephone unit.

Next, as outlined above, Lahtinen does not disclose or teach discounting a call for any reason. Second, Toda does not disclose or teach discounting a call for any reason. Therefore, the references alone or in combination cannot teach or suggest discounting a nighttime call as claimed in claims 7 and 22 or discounting a weekend call as claimed in claims 8 and 23.

Furthermore, there can be no motivation to combine Lahtinen with Toda to store data in the memory of a cellular telephone unit, as claimed in claim 32. Lahtinen teaches that it is desirable to prevent mobile system overload while storing or updating location information relating to mobile stations in a VLR (col. 2, lines 11-14). Thus, Lahtinen is addressing problems at a base station that simply cannot be solved by storing data at the cellular phone level. In fact, storing such data at the cellular phone level would be harmful, according to Lahtinen, since the data could be lost if the phone is deactivated or leaves the service area. Therefore, combining the alleged teachings of Toda with Lahtinen would destroy the principle of operation of Lahtinen, in contravention of the strictures of §103(a).

Yet further, claims 7, 8, 22, and 23 depend from allowable claims 1 or 16 as outlined above, and are therefore allowable for at least the same reasons.

Withdrawal of the rejections to claims 7-8, 22-23, and 32 is requested.

**C) Claims 3 and 18 were rejected under 35 U.S.C. §103(a) under Lahtinen
in view of Schwedes**

The rejection of claims 3 and 18 as unpatentable over Lahtinen in view of Schwedes is traversed. Claims 3 and 18 are dependent claims, depending from claims 1 and 16, and are therefore patentable over Lahtinen in view of Schwedes for at least the same reasons as claims 1 and 16 above. Where an independent claim is nonobvious, any claim depending therefrom is also non-obvious. See MPEP 2143.03 (If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is non-obvious. *In re Fine*, 837 F.2d 1071, 5 USPQ 1596 (Fed Cir. 1988)).

Withdrawal of the rejections to claims 3 and 18 is requested.

**D. Claims 4 and 19 were rejected under 35 U.S.C. §103(a) under Lahtinen
in view of Abe**

The rejection of claims 4 and 19 as unpatentable over Lahtinen in view of Abe is traversed. Claims 4 and 19 are dependent claims, depending from claims 1 and 16, and are therefore patentable over Lahtinen in view of Abe for at least the same reasons as claims 1 and 16 above. Where an independent claim is nonobvious, any claim depending therefrom is also non-obvious. See MPEP 2143.03 (If an independent claim is non-obvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ 1596 (Fed Cir. 1988)).

Withdrawal of the rejections to claims 4 and 19 is requested.

E. Claims 5 and 20 were rejected under 35 U.S.C. §103(a) under Lahtinen view of Kraushaar.

The rejection of claims 5 and 20 as unpatentable over Lahtinen in view of Kraushaar is traversed. Claims 5 and 20 are dependent claims, depending from claims 1 and 16, and are therefore patentable over Lahtinen in view of Kraushaar for at least the same reasons as claims 1 and 16 above. Where an independent claim is nonobvious, any claim depending therefrom is also non-obvious. See MPEP 2143.03 (If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is non-obvious. *In re Fine*, 837 F.2d 1071, 5 USPQ 1596 (Fed Cir. 1988)).

Withdrawal of the rejections to claims 5 and 20 is requested.

E. Claims 9-11 and 24-26 were rejected under 35 U.S.C. §103(a) under Lahtinen in view of Spitaletta.

The rejection of claims 9-11 and 24-26 as unpatentable over Lahtinen in view of Spitaletta is traversed. Claims 9-11 and 24-26 are dependent claims, depending from claims 1 and 16, and are therefore patentable over Lahtinen in view of Spitaletta for at least the same reasons as claims 1 and 16 above. Where an independent claim is nonobvious, any claim depending therefrom is also non-obvious. See MPEP 2143.03 (If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ 1596 (Fed Cir. 1988)).

Claims 12, 13, 27 and 28 are dependent claims, depending from claims 1 and 16, and are therefore patentable over Lahtinen in view of Spitaletta for at least the same reasons as claims 1 and 16 above. Where an independent claim is nonobvious, any claim depending therefrom is also non-obvious. See MPEP 2143.03 (If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ 1596 (Fed Cir. 1988)).

Withdrawal of the rejections to claims 9-11 and 24-26, 12, 13, 27 and 28 is requested.

F. Claims 14-15 and 29-30 were rejected under 35 U.S.C. §103(a) under “the above” in view of Brown

The rejection of claims 14-15 and 29-30 as unpatentable over “the above” in view of Brown is traversed. First, Appellants are unable to determine a citation for a reference termed “the above.” No such patent or reference is previously listed in the rejections, and no such citation exists elsewhere in the file. In the event that the Examiner intended to reject over each of Lahtinen, Spitaletta, Kraushaar, Abe, Toda, and Schwedes, or some subcombination, Appellants had requested that the Examiner make clear the basis for the rejection, but the Examiner failed to do so.

Regardless, however, claims 14-15 and 29-30 are dependent claims, depending from claims 1 and 16, and are therefore patentable over “the above” in view of Brown for at least the same reasons as claims 1 and 16 above. Where an independent claim is nonobvious, any claim depending therefrom is also non-obvious. See MPEP 2143.03 (If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ 1596 (Fed Cir. 1988)).

Withdrawal of the rejections to claims 14-15 and 29-30 is requested.

SUMMARY

The Appellants respectfully submit that claims 1-32 fully satisfy the requirements of 35 U.S.C. §§102, 103 and 112. In view of the foregoing, favorable consideration and early passage to issue of the present application is respectfully requested.

Dated: **June 26, 2007**

Respectfully submitted,
KULVIR S. BHOGAL, *et al.*

/FRANK C. NICHOLAS/

CARDINAL LAW GROUP
1603 Orrington Avenue, Suite 2000
Evanston, IL 60201
(847) 905-7111

FRANK C. NICHOLAS,
Registration No. (33,983)
Attorney for Appellants

10. APPENDIX

1. Method of tracking communications usage time comprising:
counting time increments in response to a call;
determining a call count based on time increments; and
modifying the call count based on calling plan parameters.
2. The method of claim 1 further comprising;
summing the modified call count; and
determining an accumulated call count.
3. The method of claim 1 further comprising;
subtracting the modified call count from a time ration; and
determining a remaining call time.
4. The method of claim 1 wherein modifying the call count comprises
rounding the call count.
5. The method of claim 1 wherein modifying the call count comprises sub-
tracting an initial open connection time from the call count.
6. The method of claim 1 wherein modifying the call count comprises dis-
counting an incoming call.

7. The method of claim 1 wherein modifying the call count comprises discounting a nighttime call.

8. The method of claim 1 wherein modifying the call count comprises discounting a weekend call.

9. The method of claim 1 further comprising;
providing a special usage parameter;
calculating a special call count based on the special usage parameter and the modified call count.

10. The method of claim 9 wherein the special usage parameter comprises a long distance parameter, and the special call count comprises a long distance usage count.

11. The method of claim 9 wherein the special usage parameter comprises a local distance parameter, and the special call count comprises a local distance usage count.

12. The method of claim 9 wherein the special usage parameter comprises a nighttime usage parameter, and the special call count comprises a nighttime usage count.

13. The method of claim 9 wherein the special usage parameter comprises a weekend usage parameter, and the special call count comprises a weekend usage count.

14. The method of claim 9 wherein the special usage parameter comprises a peak usage parameter, and the special call count comprises a peak usage count.

15. The method of claim 9 wherein the special usage parameter comprises an off-peak usage parameter, and the special call count comprises an off-peak usage count.

16. A computer usable medium including a program for tracking communications usage time comprising:

computer readable program code for counting time increments in response to a call;

computer readable program code for determining a call count based on time increments; and

computer readable program code for modifying the call count based on calling plan parameters.

17. The computer usable medium of claim 16 further comprising;

computer readable program code for summing the modified call count;

and

computer readable program code for determining an accumulated call count.

18. The computer usable medium of claim 16 further comprising;

computer readable program code for subtracting the modified call count from a time ration; and

computer readable program code for determining a remaining call time.

19. The computer usable medium of claim 16 wherein modifying the call count comprises rounding the call count.

20. The computer usable medium of claim 16 wherein modifying the call count comprises subtracting an initial open connection time from the call count.

21. The computer usable medium of claim 16 wherein modifying the call count comprises discounting an incoming call.

22. The computer usable medium of claim 16 wherein modifying the call count comprises discounting a nighttime call.

23. The computer usable medium of claim 16 wherein modifying the call count comprises discounting a weekend call.

24. The computer usable medium of claim 16 further comprising;
computer readable program code for providing a special usage parameter;
computer readable program code for calculating a special call count
based on the special usage parameter and the modified call count.

25. The computer usable medium of claim 24 wherein the special usage parameter comprises a long distance parameter, and the special call count comprises a long distance usage count.

26. The computer usable medium of claim 24 wherein the special usage parameter comprises a local distance parameter, and the special call count comprises a local distance usage count.

27. The computer usable medium of claim 24 wherein the special usage parameter comprises a nighttime usage parameter, and the special call count comprises a nighttime usage count.

28. The computer usable medium of claim 24 wherein the special usage parameter comprises a weekend usage parameter, and the special call count comprises a weekend usage count.

29. The computer usable medium of claim 24 wherein the special usage parameter comprises a peak usage parameter, and the special call count comprises a peak usage count.

30. The computer usable medium of claim 24 wherein the special usage parameter comprises an off-peak usage parameter, and the special call count comprises an off-peak usage count.

31. A communications usage time tracking system comprising:
means for counting time increments in response to a call;
means for determining a call count based on time increments; and
means for modifying the call count based on calling plan parameters.

32. A method of tracking communications usage time comprising:
counting time increments in response to a call;
determining a call count based on time increments;
modifying the call count based on calling plan parameters; and
storing the modified call count in the memory of a cellular telephone unit.

Evidence Appendix

None

Related Proceedings Appendix

None.